

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

ROBERT BOSCH LLC,	)	
	)	
Plaintiff,	)	C.A. No. 08-542-SLR
	)	
v.	)	<b>JURY TRIAL DEMANDED</b>
	)	
PYLON MANUFACTURING CORP.,	)	<b>PUBLIC VERSION</b>
	)	
Defendant.	)	

**PLAINTIFF'S MOTION FOR LEAVE TO AMEND**

In a patent infringement counterclaim, defendant Pylon has accused plaintiff Bosch of infringing U.S. Patent 6,640,380 ("the '380 patent") (*see* D.I. 6 at 9). Pylon inventor Vambi Tolentino was deposed in Miami on July 30, 2009. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Pylon has refused to consent to Bosch's proposed amendment of its pleadings to include inequitable conduct and invalidity defenses and related counterclaims based on [REDACTED]

[REDACTED] Pursuant to Federal Rule of Civil Procedure 15(a)(2), 16(b) and D. Del. LR 15.1, Bosch therefore moves for leave to file an amended pleading (attached as Exhibit 1; a version showing the changes from the previous pleading, required by D. Del. LR 15.1(b), is attached as Exhibit 2).

**Facts**

The patent statutes require that a patent application include an inventor's oath. *See* 35 U.S.C. §§ 111(a)(2)(C) and 115. The Code of Federal Regulations specifically requires that the

oath must “State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims . . . .” 37 C.F.R. 1.63(b)(2).<sup>1</sup>

Pylon's '380 patent (*see* Ex. 1 to D.I. 6) identifies Vambi Tolentino as one of two listed inventors. During the prosecution of the application that led to the issuance of Pylon's patent in suit, Pylon's patent lawyers submitted to the Patent Office a declaration, signed by Mr. Tolentino, which included the required statement that Mr. Tolentino had reviewed and understood the application (*see* Ex. 3A hereto, the Pylon production version of the declaration, PYL001207-09 at PYL001207; Ex. 3B hereto, a certified copy of the same document obtained from the Patent Office files, BOS\_LL0799338-340 at BOS\_LL0799338). The oath signed by Mr. Tolentino noted that "willful false statements may jeopardize the validity of the application or any patent issued thereon" (*id.* at PYL001208, BOS\_LL0799339.)

[illegible]

<sup>1</sup> Among other things, section 1.63 of the Code also requires that the oath state that the inventor understands his or her duty of candor to the Patent Office, and that the inventor believes himself or herself to be an inventor of what is claimed in the application; these requirements cannot be fulfilled if the inventor has not read and understood the contents of the application.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]



materially false information to the PTO during prosecution.” *Digital Control Inc. v. Charles Machine Works*, 437 F.3d 1309, 1313 (Fed. Cir. 2006). A false statement need not have been necessary to obtain a patent to be material, as long as a “reasonable examiner” would have considered the information in the statement “important in deciding whether to allow the parent application.” *Id.* at 1314–1318 (holding false declaration material despite contention that the false statement did not affect patentability); *see also, e.g., Nilssen v. Osram Sylvania, Inc.*, 504 F.3d 1223, 1232 (Fed. Cir. 2007) (“a misrepresentation that would not have immediately affected patentability is still material”); *Ulead Sys., Inc. v. Lex Computer & Mgmt. Corp.*, 351 F.3d 1139, 1146 (Fed. Cir. 2003) (holding false statement in small-entity declaration in connection with post-issuance fee payment to be material); *Refac Int’l, Ltd. v. Lotus Dev. Corp.*, 81 F.3d 1576, 1581 (Fed. Cir. 1996) (holding omission of information concerning employment history of ostensibly disinterested declarants to be material); *General Electro Music Corp. v. Samick Music Corp.*, 19 F.3d 1405, 1410–11 (Fed. Cir. 1994) (holding false statement in petition for accelerated examination to be material).

The legislative history shows that the Patent Office considers submission of an application not reviewed by the applicants to be material: Until 1992, the Regulations specifically stated that an application “may be stricken from the files” if the Patent Office discovered that the required oath was “signed without review of the specification, including the claims.” 37 C.F.R. § 1.56(c)(3) (former). In 1992, this provision was deleted in conjunction with the decision that the Office would no longer itself investigate inequitable conduct.<sup>2</sup>

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<sup>2</sup> “Section 1.56 is proposed to be amended by eliminating the provisions of current paragraphs (b)–(f) which are inconsistent with the intention of the Office to no longer investigate issues of fraud and inequitable conduct except under unique circumstances, and to no longer strike an application for improper execution.” 56 Fed. Reg. 37321 (proposed August 6, 1991).

[REDACTED]

[REDACTED] See generally, e.g., *Digital Control*, 437 F.3d at 1314-16 (discussing applicable standards of materiality). [REDACTED]

[REDACTED] then the oath and review-and-understand requirements of the Code would not have been met, and the examiner would have refused to issue the patent as prescribed in the M.P.E.P. See, e.g., *Applied Materials, Inc. v. Multimetrix, LLC*, No. 06-07372, 2008 WL 2892453, at \*5 (N.D. Cal. July 22, 2008) (holding forged declaration of deceased inventor to be material even though it “did not relate to patentability,” noting that “the Federal Circuit has repeatedly commented that in contrast to cases where allegations of fraud are based on prior art, there is no room to argue that submission of false affidavits is not material,” and collecting cases) (internal quotation marks and brackets omitted).

And under these circumstances, [REDACTED] alone is enough to give rise to an inference of intent to deceive: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. See, e.g., *Paragon Podiatry Lab., Inc. v. KLM Labs., Inc.*, 984 F.2d 1182, 1190 (Fed. Cir. 1993) (noting that the intent element of inequitable conduct “must generally be inferred”); see also, e.g., *Exergen Corp. v. Wal-Mart*

*Stores, Inc.*, Nos. 2006-1491 & 2007-1180, slip op. at 19–30 (Fed. Cir. Aug. 4, 2009) (explaining pleading standards for intent element of inequitable conduct); *Nilssen*, 504 F.3d at 1235 (“Given that these material references were repeatedly before Nilssen, and his failure to offer any good faith explanation for withholding them other than mere oversight, we find an inference that Nilssen intended to deceive the PTO not unreasonable”).

Pylon’s patent is thus both unenforceable for inequitable conduct [REDACTED]

[REDACTED] and invalid [REDACTED]  
[REDACTED]

**B. There is good cause for the proposed amendment**

There is good cause for making the proposed amendment, even though the scheduled date for amendments has already passed. As noted above, the Court’s order provided that amended pleadings were to be filed by March 11, 2009. However, until Mr. Tolentino’s deposition, the facts giving rise to these new inequitable conduct and invalidity defenses and counterclaims were known only to Pylon. Bosch thus could not have asserted the new defenses and counterclaims before the deadline to amend. After learning of the facts giving rise to its new defenses and counterclaims, Bosch promptly sought Pylon’s consent to the proposed amendment, and then filed this motion to amend.

Nor will Pylon will be unfairly prejudiced if the amendment is allowed; the information regarding inequitable conduct remains exclusively within Pylon’s control, and there is ample time remaining before the April 12, 2010, trial for Pylon to prepare a response to these defenses and counterclaims.

Under such circumstances, it is appropriate to allow a party to amend its pleadings. *See, e.g., Cordance Corp. v. Amazon.com*, 255 F.R.D. 366, 372 (D. Del. 2008) (allowing an accused

infringer to amend to assert an inequitable conduct shortly after inventors' depositions); *Freres v. SPI Pharma, Inc.*, C. A. No. 06-540, 2009 WL 1444835 (D. Del. May 21, 2009) (same).

Bosch therefore respectfully requests the Court grant leave for it to file the enclosed Amended Answer and Counterclaims.

Respectfully submitted,

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931647/33181



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**CERTIFICATE OF SERVICE**

I, David E. Moore, hereby certify that on September 2, 2009, the attached document was electronically filed with the Clerk of the Court using CM/ECF which will send notification to the registered attorney(s) of record that the document has been filed and is available for viewing and downloading.

I hereby certify that on September 2, 2009, the attached document was Electronically

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